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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/391,294 09/07/99 WILSON

R CBC-122-C

EXAMINER

PM82/0427

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ART UNIT

PAPER NUMBER

3635

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/391294
Filing Date: 09/07/1999
Appellant(s): Wilson et al.

MAILED

APR 27 2001

GROUP 3600

Darlene Condra
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 03/21/01.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

Art Unit: 3635

(2) *Related Appeals and Interferences*

There are no related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

Art Unit: 3635

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because applicant fails to provide reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Regarding the recapture rejection each of the independent claims has broadened the same limitation.

As to the art rejections claim 5 is substantially identical to claim 1 absent all of the intended use environment language.

As such, the examiner believes the claims stand or fall together

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

2,091,316

Hauck

08/31/1937

Art Unit: 3635

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Issue No. 1 Recapture

Claims 1-5 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The limitation “wherein said first and second longitudinally extending portions have lengths corresponding to the length of the corner of the building” has been omitted from the claims. The limitation was presented in an amendment in application serial number 08/639698 filed on 12/06/96. Applicant’s remarks in the amendment contains arguments that the limitation

Art Unit: 3635

make the claims allowable over the prior art of record. Thus, the omitted limitations relate to subject matter previously surrendered, in application serial number 08/639698.

Issue No. 2 102(b) Rejection

Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,091,316 to Hauck.

Hauck provides in figure 2 a member 6 having first and second longitudinally extending portions defining a cornered inner surface each having a radially outwardly extending flange 5. The claims are considered to be drawn to the member alone not in combination with a building and corner post. The wood 6 is a material having insulating qualities.

(11) Response to Argument

Issue No. 1 Recapture

In *Clements*, 131 f.3d at 1468-69, 45 USPQ2d, the Court of Appeals for the Federal Circuit set forth a two step test for recapture.

The first step is to determine whether and in what aspects the reissue claims are broader than the patent claims.

Applicant argues that the limitation "wherein said first and second longitudinally extending portions have lengths corresponding to the length of the building" has not been omitted from claim 1.

Art Unit: 3635

The examiner disagrees. The limitation in claim 1 is written as "wherein said first and second longitudinally extending portions have lengths *adapted for* corresponding to the length of the building" (emphasis added).

It is the examiner's position the inclusion of "adapted for" broadens the scope of the claim.

Applicant states that the language "adapted for" was added to overcome a rejection under 35 USC 112(2) made by the examiner.

It is noted that claims in a reissue enjoy no presumption of validity. See MPEP 1445. The fact that the examiner had made a rejection under 35 USC 112(2) is not germane to the recapture rejection. Further, the 112(2) rejection could have been overcome by amending the claims to be clearly directed to a combination including the building without broadening the limitation of the lengths of the first and second extending portions.

The first step has been met as the insertion of the language "adapted for" broadens the limitation.

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. One looks to the prosecution history for arguments and changes to the claims made in an effort to overcome prior art rejections.

Applicant added the limitation "wherein said first and second longitudinally extending portions have lengths corresponding to the length of the building" in the amendment filed

Art Unit: 3635

12/06/96 in parent application 08/639698 (see applicant Appendix A). Applicant argued this limitation made the claims allowable at page 4 lines 23+ of the amendment.

If a limitation now being omitted or broadened was originally presented/argued/stated in the original application to make claims allowable over a rejection, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

Regarding claim 5, since the broadening aspect is related to a prior art rejection recapture is proper using the analysis applied to claim 1 above.

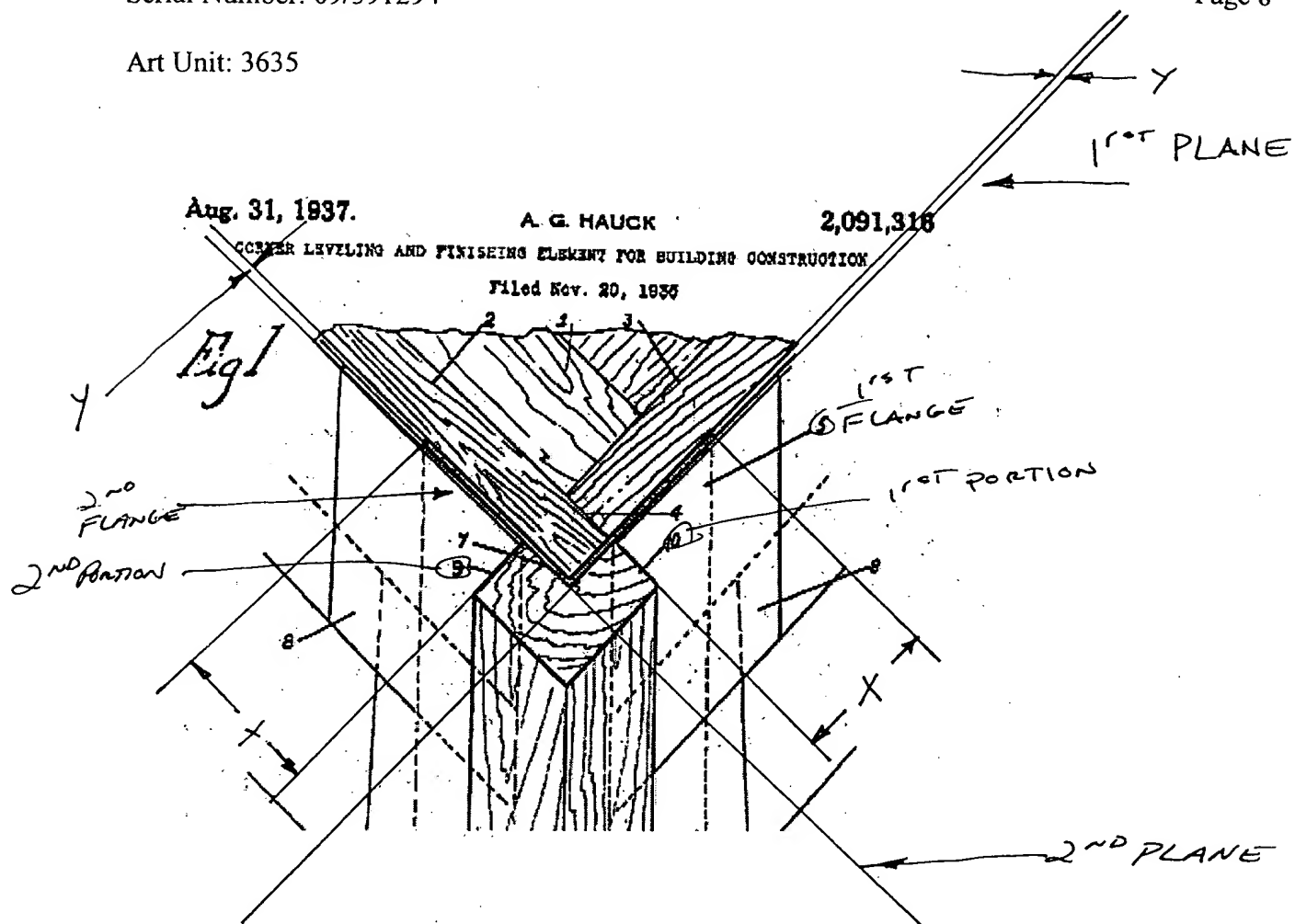
Since, each of the steps set forth by the Court have been met the examiner believes the recapture rejection should be sustained.

Issue No. 2. 102(b) Rejection

Applicant argues that the flanges of Hauck do not extend from the portions. It is the examiner's position that the flanges can be interpreted to extend from the portions in the directions X and/or Y in the marked up figure below.

Applicant argues that Hauck is made from two different materials and as such cannot be considered a single member. It is the examiner's position that the two members taken together meet the limitations "single member". The limitation "single member" does not preclude the member being made from separate components/elements.

Art Unit: 3635



For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Robert Canfield

April 25, 2001

Conferees: MS, CF

Robert Canfield
Primary Examiner